

O-048-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2334028
BY DEVON COUNTY COUNCIL
TO REGISTER THE CERTIFICATION MARK:**



IN CLASS 35

AND

**THE OPPOSITION THERETO
UNDER NO 92714
BY CUSTOMER FIRST (UK) LIMITED
BASED UPON THE EARLIER CERTIFICATION MARKS (SERIES OF
TWO):**



Trade Marks Act 1994

**In the matter of application no 2334028
by Devon County Council
to register the certification mark:**



**in class 35 and the opposition thereto
under no 92714
by Customer First (UK) Limited**

BACKGROUND

1) On 5 June 2003 Devon County Council, which I will refer to as Devon, applied to register the certification mark:



The application was published for opposition purposes in the "Trade Marks Journal" on 21 May 2004 with the following specification:

business services relating to customer service procedures.

The above services are in class 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Devon claims the colour red as an element of the trade mark.

2) On 13 August 2004 Customer First (UK) Limited, which I will refer to as Limited, filed a notice of opposition against the application. Limited is the owner of the following United Kingdom certification trade marks (a series of two):



The trade marks are registered for the following goods and services:

printed matter; publications; books; stationery; notepaper; business cards; calendars; booklets; informational literature; advertisement boards; promotional literature; posters; photographs;

business and commercial consultancy and advisory services; business support services; assistance in the management of business affairs and commercial functions; accountancy services; advertising and marketing services; personnel management and advisory services; organisation of trade fairs for commercial and advertising purposes;

financial advice services; insurance services; stockbroking and banking services;

training and educational services; organisation of conferences and seminars; entertainment services; leisure services;

quality assurance of customer and business services.

The above goods and services are in classes 16, 35, 36, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Limited claims the colours purple (Pantone 298) and blue (Pantone 248) as elements of the first mark in the series.

The application for the certification marks was filed on 13 March 2003 and the marks were registered on 4 March 2005.

Limited claims that the respective certification marks are similar and that the respective goods and/or services are similar or identical. Consequently, there is a likelihood of confusion and registration of the certification mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Devon filed a counterstatement. It denies that the respective certification marks are similar. It claims that the phrase “customer first” is in common usage, often incorporated into a promotional statement or device. It considers that the words “customer first” are in the public domain and, if its collective mark was registered, it would not seek to restrict its common usage. Devon would only seek to restrict designs or logos which resembled its own distinctive device. It states that there are significant differences in the actual target groups of each scheme. Devon claims that the framework of the “Putting the Customer First” initiative is a quality assurance standard for publicly funded business support providers. Its scheme is operated by Devon County Council Trading Standards Service and focuses exclusively upon the customer service procedures of retail businesses. It claims that the Small Business Service was involved with the schemes of both sides. Devon submits that if one of the main stakeholders of the “putting the customer first” initiative had considered that there was any danger of confusion it is to be expected that it would have raised its concerns.

4) Both sides furnished evidence.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing, a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Devon provided written submissions. Consequently, this decision is made from the evidence and written submissions before me.

EVIDENCE

Opponent’s evidence

6) This consists of a witness statement by Paul Randle. Mr Randle is an associate solicitor with Briffa Solicitors. He is representing Limited in this case. Mr Randle’s statement represents submissions rather than evidence of fact. In the normal course of events I would not summarise what he says as it is not evidence of fact. However, as Limited have not furnished specific submissions and there has not been a hearing, I will summarise the main points that he makes. Mr Randle states that the similarity of trade marks requires a global appreciation. He refers to *Procter & Gamble Company v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-383/99P [2002] ETMR 3*. He states that the principal and dominant elements of Limited’s certification mark are the words Customer First. He states the words “putting the” are in “narrow gauge and comparatively smaller font”. The words “putting the” are above the other words and have the effect of reducing their prominence to the average consumer. He states the average consumer is prone to scan a mark which includes written text from left to right. The first word that the consumer will see will be Customer. He states that the first word of a mark has a primary impact which is often, as in this case, maintained even upon the subsequent reading of “both dominant and submissive elements”. Mr Randle states that if Limited’s mark is read in another way, the words Customer First are the dominant elements. He states that Devon’s mark consists of the words Customer First with some minor styling to the letter F. Mr Randle states that this stylisation is devoid of distinctive character. Alternatively, he claims that the stylised F is of such “weakly” distinctive character that it does not alter the dominant impression upon the observer

of the words Customer First. Mr Randle claims that on a “visual appreciation” of the distinctive and dominant elements of Devon’s mark it consists exclusively of the words Customer First. The respective marks have a high degree of visual similarity that can be characterised as near identity.

7) Mr Randle states that the dominant and distinctive elements of Limited’s trade mark, when considered aurally, are the words Customer First. He states that Devon’s mark consists entirely of the notion of placing, allocating, putting or otherwise prioritising customers above other considerations. He states that, therefore, the respective marks are conceptually identical.

8) Mr Randle states that the services of the application fall squarely within the class 35 specification of Limited’s mark. He claims that the services are identical. Mr Randle refers to *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

9) Mr Randle claims that Devon’s comments re the words Customer First being in the public domain relate to the registrability of Limited’s mark. He states that it is a general principal of United Kingdom trade mark practice that a trade mark is assumed to be distinctive unless it is challenged. He claims that the use of the words Customer First does not undermine or affect the distinctiveness of Limited’s mark.

10) Mr Randle denies that the Small Business Service were given an opportunity or did in fact compare the marks or assessed the likelihood of confusion. He states that the relevant consumer in this case is a business seeking advice and not a funding organisation. In the alternative, Mr Randle claims that given that both sides have a common funding organisation this reinforces the likelihood that the relevant public will consider that the parties are connected, when they are not.

11) Mr Randle goes on to raise issues re Schedule 2 clause 2 of the Act. This relates to absolute grounds of refusal, ie something inherent in the mark, it is not a relative ground of refusal. This ground has not been pleaded and the argument in relation to it relates to a relative issue. I will, therefore, say no more about it. Mr Randle also makes reference to section 3(2)(b) of the Act in relation to reverse confusion. Section 3(2)(b) of the Act relates to trade marks which consist of the shape of goods which is necessary to obtain a technical result. I assume that there is an error but I am unsure to what Mr Randle was meant to be referring. It is not a matter that has been pleaded and so I need say no more about it. Mr Randle also states that the preliminary indication in this case stated that the respective services are identical or similar.

Evidence of Devon

12) This consists of a witness statement by Paul Thomas. Mr Thomas is the Fair Trading Manager of Devon County Council Trading Standards Service. Parts of Mr Thomas’s statement is submission rather than evidence of fact. Mr Thomas makes an analysis of the respective marks and comes to the conclusion that there is not a significant degree of similarity.

13) Mr Thomas states that the framework of the “Putting the Customer First” initiative is a quality assurance standard for publicly funded support providers. He

states that the main target is small businesses. Mr Thomas states that Devon's scheme focuses exclusively on the customer service procedures of retail businesses. He states that the main target of Devon's scheme is consumers.

14) Mr Thomas states the phrase "customer first" is in common usage, often incorporated into a promotional statement or device. Mr Thomas exhibits material in relation to this:

- Printout from Exeter City Council's website:

"Customer First – Excellence in customer service..... The *Customer First* Project is looking at how the Council can optimise the customer experience...
- Printout from BrandAware website on how to manage a "Customer First" brand.
- Printout from Caerphilly Council's website headed "CUSTOMER FIRST".
- Printout from PAC International website on its Customer First programme.
- Printout from Balloons To Go website about its Customer First card.
- Printout from Calderdale Council's website about Calderdale Customer First.
- Printout from Richmond Council's website about its Customer First policy.
- Case details of trade mark registration no 2173836 of the Norwich and Peterborough Building Society of CUSTOMER FIRST stylised. The registration is in classes 16, 35, 36 and 41.
- Printout in relation to the magazine "Customer First" which is described as being for all customer service professionals.
- Printout from the EWS Railways website headed "Customer 1st".
- Printout from William Sutton Housing Association about its Customer First Standards.
- Printout from Scarborough Council's website about its Customer First initiative.

15) Mr Thomas exhibits at exhibit 5 a page from Limited's website. This advises that the certification mark is used as a quality assurance standard for publicly funded business support providers. Exhibited at exhibit 6 is documentation relating to Devon's application for funds from the Small Business Service for its Customer Service project. Mr Thomas states that the Small Business Service had ample opportunity to compare the respect certification marks.

16) Mr Thomas states that the words “customer first” are in common usage and consumers will not rely upon them as being the distinctive and dominant elements of the respective marks.

Evidence in reply of Limited

17) This consists of a further witness statement by Paul Randle. Like his first witness statement it does not include evidence of fact but submissions, in this case a critique of the evidence of Devon. Mr Randle states that Customer First is not commonly used as a trade mark. He states that exhibits 3A – 3G do not show use of the phrase Customer First for the services of the application.

Submissions of Devon

18) Devon effectively repeats the points that it made in its evidence. It also requests the registrar uphold the decision of the preliminary indication in this case.

DECISION

Preliminary indication

19) Both sides have made reference to the preliminary indication. I have not looked at this indication. The preliminary indication is an administrative action, which is why it is not subject to appeal. Devon refers to it as a decision; it is certainly not that. It is there to give some indication as to how a case might go; to possibly help expedite matters between the parties. It would undermine the rôle of the registrar as an independent tribunal if weight was to be given to the preliminary indication. I have to consider the matters before me, on the basis of the evidence before me, the submissions made to me and my own understanding of the law and the facts of the case before me. My rôle is not to rubber stamp preliminary indications. If the preliminary indication was to have an effect upon me it would take on a quasi judicial form rather than being an administrative advice. A preliminary indication represents the view of a particular hearing officer at a particular point of time; no more than that. It is to be noted that it is the registrar’s policy that the person giving a preliminary indication is not the hearing officer responsible for the case. It is inevitable, and a healthy sign, that hearing officers at times will come to a conclusion different to that expressed in a preliminary indication; even in a case where no evidence has been filed. In this case, of course, both sides have filed evidence and Devon’s evidence includes evidence of fact.

Likelihood of confusion – section 5(2)(b) of the Act

20) Section 1(2) of the Act states:

“(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see section 49) or certification mark (see section 50).”

Section 50 (2) of the Act states:

“(2) The provisions of this Act apply to certification marks subject to the provisions of Schedule 2.”

21) Consequent upon the above the provisions of section 5(2)(b) of the Act apply to certification marks.

22) According to section 5(2)(b) of the Act a trade mark (or certification mark) shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

Limited’s registration is an earlier mark within the terms of section 6(1)(a) of the Act.

23) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

24) Reference has been made to the Small Business Service and its common rôle in relation to the two certification marks. The Small Business Service as far as I am aware does not have an expertise in trade mark law. That both sides have made use of its services does not indicate whether there would be confusion or not. It is my job to decide whether there is a likelihood of confusion.

Comparison of services

25) In *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61 the Court of First Instance (CFI) stated:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03 the CFI held:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

Geoffrey Hobbs QC, sitting as the appointed person, in *Croom's Trade Mark Application* [2005] RPC 2, stated:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account. However, the protection

claimed by the opponent independently of registration (*i.e.* under s.5(4)(a) of the Act) must relate to the actual and anticipated use of the rival marks.”

The effect of the above authorities is that in considering goods or services in specifications it is necessary to consider them across the entire gamut of normal and fair use. The specification cannot be limited to either an intention or the nature of use at a particular point in time. This reasoning applies to trade marks, where there is nothing in the registration or application to effectively limit the nature of the use. Certification marks are in a somewhat different position. They are governed not only by a specification but also by the regulations of the scheme. In the case of Devon’s scheme annex A to the regulations states: “The Scheme only applies in respect of business to consumer transactions”. An amendment to the regulations can only be effected by applying to the registrar who may publish the amendment for opposition purposes if he thinks so fit (schedule 2 paragraph 11 of the Act). Consequently, in this case Devon does not have the same freedom in relation to the use of the mark as a trade mark owner would have; without an amendment of the regulations there is a restriction to “business to consumer transactions”. It may be that this should be taken into account, that a different position should be adopted to that in relation to trade marks. In this case the earlier right is also a certification mark. Devon has made comments about how it is used and upon what it has been used. However, the regulations have not been furnished and so I cannot see if there are any regulatory restrictions to its use. I must, therefore, consider normal and fair usage in relation to all of the class 35 services of the earlier registration. This registration is for *business and commercial consultancy and advisory services; business support services; assistance in the management of business affairs and commercial functions; accountancy services; advertising and marketing services; personnel management and advisory services; organisation of trade fairs for commercial and advertising purposes*. I cannot see how the services of the application cannot but include *business services relating to customer service procedures* (even if it was possible to consider that such services were effectively restricted by the scheme regulations). **Consequently, I find that the respective services are identical.**

Comparison of certification marks

26) The certification marks to be compared are:

Limited's registration:



Devon's application:



One of Limited's marks claims colour, the other doesn't. In *Robert McBride's Application* [2003] RPC 19 Mr Geoffrey Hobbs QC, sitting as the appointed person stated:

“14. It is assumed, unless otherwise stated, that trade mark registration has been requested and conferred on the basis that use of the relevant mark in colour is neither claimed nor disclaimed. The absence of a colour claim or limitation effectively makes it a condition of registration that no colouring is necessary for the mark in question to possess a distinctive character: Cases T-128/00 and T-129/00 *Procter & Gamble Company v. OHIM* (19th September 2001) paragraph 55. A mark validly registered without a colour claim or limitation may therefore be taken to have been used when it appears in colour no less than when it appears in black-and-white, if the representation conforms to the template or pattern of the mark as registered.”

Consequently, the certification mark without a colour claim has no restriction and normal and fair use can encompass it is in various colours or none. I will consider this mark; if Limited does not succeed in relation to this I cannot see how it could succeed in relation to its coloured mark. Devon claims the colour red as an element of its mark. In the same decision Mr Hobbs states:

“8. An application for registration can be made subject to: (i) a colour claim confirming that a specified colour or colour scheme forms part of the trade mark to which the claim relates; or more restrictively: (ii) a colour limitation confirming that a specified colour or colour scheme is indispensable to the identity of the trade mark to which the limitation applies. Both possibilities involve the voluntary adoption of a "limitation" within the meaning of that expression as used in s.13 of the Act.”

So the red colour part of Devon's certification mark is an intrinsic part of the mark.

27) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (Judgment of the Court of First Instance (CFI) in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02 [2005] ETMR 22).

28) Mr Randle virtually ignores the device element of the trade mark. He submits that this opposition is not the appropriate forum for considering the validity of Limited’s mark. However, Devon has not questioned the validity of the registration; what it has done is contested that the word element of the registration has any distinctiveness and whether it can be protected. So effectively Devon is stating that the distinctiveness in Limited’s mark lays in its device element. Mr Randle submits that the evidence in relation to customer first does not relate to trade mark use or use in relation to the services in question. I do not see that whether a term is distinctive depends on issues relating to trade mark use; in fact the very opposite is normally the case. What Devon’s evidence shows, and I think shows clearly, is the Customer First is a phrase that is used widely in relation to services supplied to others, whether it be via a local authority or a railway company. Limited’s trade mark includes the words “putting the Customer First”, the point and purpose of the customer first policies of the various undertakings exhibited by Devon. The inclusion of the words “putting the” convert the phrase, in my view, into a laudatory exhortation or a laudatory statement of intent. I cannot see that the average consumer for business services, or any consumer, is likely to give any trade mark significance to these words. They are likely to just see them as a puff, without being educated to see them otherwise. As per *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* it is necessary to consider the perception of an average consumer.

29) In *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening*(Case T-129/01) [2004] ETMR 15 the CFI stated:

“The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.”

This is a view that the CFI has also upheld in *Koubi v OHIM – Flabesa (CONFORFLEX)* Case T-10/03, paragraph 60 and *Grupo El Prado Cervera v OHIM – Debuschewitz (CHUFAFIT)* Case T-117/02, paragraph 51. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the CFI stated:

“59. It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).”

Geoffrey Hobbs QC, sitting as the appointed person, stated in *Torreomar* [2003] RPC 4:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283).”

In *Chum Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T-359/02 the CFI stated:

“44 In that connection, it is appropriate to state at the outset that the words ‘star TV’ constitute both the mark applied for and the verbal element of the earlier mark. In similar circumstances, the Court of First Instance held that a complex word and figurative mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).”

In *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (*OHIM*) Case T-3/04 the CFI held:

“45. It must be stated that, contrary to what the applicant maintains, where a sign consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant.”

In *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 the ECJ stated:

“29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in

question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).”

30) I have no hesitation in stating that the distinctive and dominant component of Limited’s mark is the device element. The word elements are totally lacking in distinctiveness and dominance. Putting non-distinctive words into a large font does not make them distinctive. The word element of Limited’s mark will not be seen as indicating origin or control. There is no similarity between the device element of Limited’s mark and that of Devon. The element that carries Devon’s mark is the implied/inferred f in red which is part f and part tick and would probably not be seen as a letter f if it was not between Customer and first. The trade marks coincide in use of, or an implication of, the words Customer First. But this is a phrase that does not have trade mark significance, it is not acting in anyway, in my view, as an indicator of origin.

31) Section 5(2)(b) of the Act, for a likelihood of confusion to be considered, requires that trade marks are similar. It is not a matter of whether they have similarities but whether they are similar; it will be a rare case where an opposition has been brought where there are no similarities. Without a decision that the trade marks are similar the case must fail. The global appreciation can only come into play when it has been decided that the trade marks are similar/identical and the goods/services are similar/identical. As the ECJ stated in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P [2005] ETMR 23:*

“53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment, that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.

54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.”

It is difficult to make a purely a priori judgement as to whether signs are similar. In practical terms part of the judgement will be a posteriori; taking into account all the relevant factors in relation to a global appreciation, is there a possibility of likelihood of confusion? If there is such a possibility, then the marks are similar for the purposes of section 5(2)(b) of the Act. If there is not, they are not. This is not to state that a finding of confusion will be an automatic sequitur where the marks are similar; merely that, subject to there being similarity/identity of the goods/services, the global appreciation can take place and a decision as to confusion can be made on the basis of that global appreciation.

32) Taking into account all the above I come to the conclusion that the respective collective marks are not similar.

Conclusion

33) The finding that the respective collective marks are not similar is fatal to the case of Limited that there is a likelihood of confusion. The interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)- cannot assist.

COSTS

34) Devon County Council having been successful is entitled to a contribution towards its costs. In Adrenalin Trade Mark, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

“It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

Consequently, as Devon has not been represented, I will make an award of two thirds of what it would have received if it had had representation. **I order Customer First (UK) Limited to pay Devon County Council the sum of £833. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

Dated this 14th day of February 2006

**David Landau
For the Registrar
the Comptroller-General**